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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/054,565	04/03/98	SIMPSON	J P-3489,027

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QM12/0731

EXAMINER

GOODMAN, J.

ART UNIT	PAPER NUMBER
3724	16

DATE MAILED:

07/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/054,565	SIMPSON, JACK RICHARD	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 6/18/01.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-10 and 14-26 is/are pending in the application.

4a) Of the above claim(s) 22,23 and 25 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-10,14-21,24 and 26-29 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____ .

16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 20) Other: _____

DETAILED ACTION

1. The Amendment filed on June 18, 2001 has been entered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the scrap stripper constructed independently of the base (claim 28) the “weighted” scrap stripper (claim 24) must be shown or the feature canceled from the claim. No new matter should be entered.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: “S” (p. 12, l. 5). Correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8-10, 14, 16-17, 19, 26, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i. In claim 8, clause (b) the term “it” is vague and indefinite. What is “it” referring to? The same applies to the rest of the claims. In line 9, the phrase “the direction of movement..” lacks clear antecedent basis.

- ii. The following phrases lack clear antecedent basis: (claim 9) "the height"; (claim 16) "the direction of travel of the cutting die" (no "travel direction" has been set forth for the cutting die); and (claim 26) "the influence of centrifugal force".
- iii. Claim 16 is vague and indefinite in that it is not clear what the claim encompasses. What is encompassed by "adapted to work in conjunction with a rotary anvil"? How is the rotary die "adapted to work"? Due to the nature of the art, the scope of the limitation is unascertainable. Substantially the same applies to claim 26.
- iv. Claim 28 is vague and indefinite in that it is not clear what the claim encompasses. What is the claim referring to and where is this shown in the drawings? Moreover, which "base" is the claim referring to, the base of the cutting die or the base of the stripper?

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-4, 6, 15-17, 19, 21, 24, 26, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Rilitz et al.

Rilitz et al discloses a cross cutter comprising all the elements claimed including, *inter alia*, a base (7, 9); at least one scrap cutting blade (8, 11); and at least one scrap stripper (13, 14). See whole patent.

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Regarding claim 16, the phrase "adapted to work..." has not been given significant patentable weight, since it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding claim 28 and as best understood thereof, the stripper, i.e. the fingers thereof, is constructed "independently" of the base since the finger is separate from the base.

8. Claims 1-6, 8-10, 14-17, 19, 21, 24, 26, 28, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Okonski.

Okonski discloses a cutting die system comprising all the elements claimed including, *inter alia*, a base/board (30); at least one scrap cutting blade (50); and at least one scrap stripper (40). See Figs. 1-4.

Regarding claim 16, the phrase "adapted to work..." has not been given significant patentable weight, since it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding claim 28 and as best understood thereof, the stripper, i.e. the fingers thereof, is constructed "independently" of the base since the finger is separate from the base.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
10. Claims 5, 7, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Rilitz et al.

Regarding claim 5, Rilitz et al discloses the invention substantially as claimed except for a plurality of scrap strippers. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Rilitz et al with a plurality of scrap strippers in order to facilitate stripping of larger area of the work piece, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 7 and 18, Rilitz et al discloses the invention substantially as claimed including the stripper being made from rubber material. See c. 4, ll. 28-33. However, Rilitz et al does not set forth a specific range of durometer. In that regard, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Rilitz et al with the claimed durometer range in order to obtain the desired elastomeric characteristic, since rubber material inherently includes a certain range of durometer values, and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

11. Claims 7, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Okonski.

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Okonski discloses the invention substantially as claimed except for the stripper being made from rubber material and durometer range. However, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Okonski with the claimed rubber material and durometer range in order to use a material with the desired stripping characteristic since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, *In re Leshin*, 125 USPQ 416, and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

12. Claims 1-10, 14-21, 24, and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smithwick Jr. et al in view of Okonski.

Smithwick Jr. et al discloses the invention substantially as claimed except for the flexible fingers 24 (on one row of fingers) extending outwardly over the base at an acute angle. However, Smithwick Jr. et al already teaches that the angular orientation of the fingers along with the adjacent notches allows the stripper to absorb compressive forces during the cutting operation while at the same time rebound to longitudinally direct a force which helps to free the scrap. See c. 4, ll. 11-28. Along that line, Okonski teaches a stripper (40) including a base (30) and flexible fingers extending outwardly over the base and at an acute angle within the range as claimed which suggests lessening of the compressive forces that the stripper experiences during the cut strip deflection and guidance operation while maintaining sufficient rebound longitudinal strength (force) to deflect and guide the cut portion of the web (70). See Figs. 1-4. Thus, it would have

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been obvious to the ordinary artisan at the time of the instant invention to provide the device and method of Smithwick Jr. et al with the finger extending over the base of the stripper at an acute angle as taught by Okonski in order to enhance the absorption of the compressive forces without compromising the longitudinally directed force required to free the scrap.

Regarding claim 16, the phrase "adapted to work..." has not been given significant patentable weight, since it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

13. Claims 1-10, 14-21, 24, and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smithwick Jr. et al in view of Wright.

Smithwick Jr. et al discloses the invention substantially as claimed except for the flexible fingers 24 (on one row of fingers) extending outwardly over the base at an acute angle. However, Smithwick Jr. et al already teaches that the angular orientation of the fingers along with the adjacent notches allows the stripper to absorb compressive forces during the cutting operation while at the same time rebound to longitudinally direct a force which helps to free the scrap. See c. 4, ll. 11-28. Moreover, Wright teaches strippers (11) each including a base (at 25) and a finger (17) extending outwardly over the base and at an acute angle within the range as claimed for the purpose of allowing the fingers of the strippers to more easily compress when pressed against an obstacle. See Figs. 1-7, c. 5, l. 5 - c. 6, l. 14. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device and method of

Smithwick Jr. et al with the finger extending over the base of the stripper at an acute angle as taught by Wright in order to facilitate ease of compression of the stripper fingers.

Regarding claim 16, the phrase "adapted to work..." has not been given significant patentable weight, since it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Response to Arguments

14. Applicant's arguments filed June 18, 2001 have been fully considered but they are not persuasive.

In response to Applicant's basic argument that the claims include sufficient antecedent basis,¹ this argument is traversed. With respect to claim 8, the phrase "the direction of movement..." lacks antecedent basis since no "direction of movement" has been set forth. Applicant's assertion that the phrase is simply describing how the angled finger acts to control the movement of the strip is noted. However, this assertion fails to take into consideration that this "movement" caused by the interaction of the fingers and the implied movement through the nip simply has not been positively set especially in light of the specification which describes that this "movement" is different than simply through the nip. See e.g. Fig. 4E of the application. Moreover, Applicant's assertions with respect to the rest of the claims are couched in the same view point that

that they simply define a general environment or set forth how certain elements act.

These assertions are baseless, since it is NOT the use of the phrase that is *per se* indefinite but rather that they do not have positive basis in the claims.

In response to Applicant's basic assertion that the claims are not anticipated by Rilitz et al,² this argument lacks merit. First, Applicant asserts that the strippers (or guides) of Rilitz et al do not have anything to do with cutting corrugated board or even scrap ejection. With regard to the corrugated board, this has not been given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). This applies to all of Applicant's arguments concerning "corrugated board". With regard to the scrap ejection function, it is not clear how the strippers of Rilitz et al would not be construed as scrap ejectors. The implied meaning of "stripper" in this instance is a structure or device that facilitates guidance of unwanted or undesirable parts from the blades of the die. In that regard, the strippers of Rilitz et al inherently performs the same function whenever the cross cutting apparatus cuts an unwanted or undesirable portion from the web, since the strippers of Rilitz et al would act on all the to-be-cut portions of the web. Second, Applicant asserts that the strippers of Rilitz et al are limited to only guiding the flexible material or web. However, Applicant fails to appreciate the fact that these strippers act on the web through a certain sector of rotation of the rotary drums which include before and after

¹ Amendment C, Paper No. 15, p. 4, l. 20 - p. 5, l. 4.

² Id., p. 6, l. 21 - p. 7, l. 12.

the actual cut. Compare Figs. 1-2 of Rilitz et al and c. 6, ll. 12-32. Thus, besides guiding, the strippers aid in disengaging the cut web from the respective dies which is the exact functionality of a stripper.

In response to Applicant's basic argument that Okonski does not anticipate the claimed invention,³ this argument lacks merit. Applicant's argument is basically couched in the assertion that Okonski does not include strippers constructed of compressible material. However, this is non-distinguishing since even "steel" is compressible to a degree.

In response to Applicant's basic argument that the claimed invention is not obvious over Smithwick Jr. et al and Okonski,⁴ this argument lacks merit.

First, in response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Second, in response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the

³ Id., p. 7, l. 13 - p. 8, l. 10.

⁴ Id., p. 8, l. 11 - p. 9, l. 20.

claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion to combine stem from both references. Smithwick Jr. et al teaches rubber (inherently resilient and compressible) strippers with fingers extending at an angle that is not acute. Moreover, Smithwick Jr. et al teaches that the angular orientation of the fingers along with the adjacent notches allows the stripper to absorb compressive forces during the cutting operation while at the same time rebound to longitudinally direct a force which helps to free the scrap. Okonski teaches strippers having the fingers disposed at an acute angle which suggest lessening of the compressive forces could be had in a resilient scrap stripper via the acute angle for performing the same stripping function. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to modify Smithwick Jr. et al with the teachings of Okonski for the reasons stated in the rejection *supra*. It is irrelevant whether Okonski is not intended to be used in slots since this is not the feature relied on with respect to Okonski. Moreover, nothing in the claims requires consideration of Applicant's point.

Third, Applicant's assertions that the ordinary artisan would not want to increase or enhance the compressive force misses the point by far. As noted in the rejection, the Examiner stated that Okonski's teachings suggest lessening of the compressive force required to perform the scrap ejecting function. Therefore, "enhancement" in the context of the rejection refers to the resulting stripper's ability to absorb more of the

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compressive forces acting thereon due to the fact that the resulting fingers would more easily "bend" and NOT to increasing these forces.

Conclusion

15. Smithwick Jr. et al '620 and Elsner are cited as additional pertinent art.
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

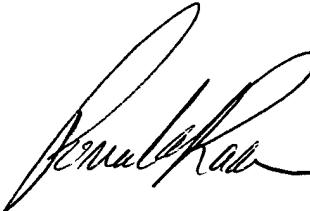
All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

**Charles Goodman
Patent Examiner
AU 3724**

cg 
July 30, 2001


Rinaldi I. Rada
Supervisory Patent Examiner
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